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10/816,827

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Lucien Amiot

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12/16/2005

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EXAMINER

TAYLOR, APRIL ALICIA

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/816,827

Applicant(s)

AMIOT ET AL.

Examiner

April A. Taylor

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Objections*

2. Claims 1-42 are objected to because of the following informalities:

Re claim 1: Substitute the term "this" with -- the -- (see lines 2, 4 and 5, respectively).

Re claims 2-20: Substitute the "Microcircuit" with -- The microcircuit -- (see line 1).

Re claim 3: Substitute the term "those" with -- the length and width-- (see line 3).

Re claim 16: Substitute the term "its" with -- the cavity-- (see line 4).

Re claim 17: Substitute the "adapted to enable it" with -- that enables the base -- (see line 3).

Re claim 21: Substitute the "Adapter" with -- An adapter -- (see line 1).

Re claim 21: Substitute the "adapted to form" with -- for forming-- (see line 1).

Re claim 21: Substitute the "and adapted to accommodate" with -- for accommodating -- (see lines 4-5).

Re claims 22-25: Substitute "Base" with -- The adapter base -- (see line 1).

Re claim 23: Substitute the term "it" with -- the adapter base -- (see line 2).

Re claim 26: Substitute "Method" with -- A method -- (see line 1).

Re claim 26: It is unclear to the examiner to what the term "it" refers to (see line 5).

Re claim 26: Substitute "this" with – the – (see line 9).

Re claims 27-41: Substitute "Method" with – The method (see line 1).

Re claim 34: Substitute "this" with – the – (see line 3).

Re claim 42: Substitute "Base" with – A base – (see line 1).

Re claim 42: Substitute "the" with – in – (see line 3).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

6. Regarding claim 17, the word "means" is preceded by the word(s) "the base is provided with a" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the

element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-8, 10-17, 19-22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Tarantino et al (US 6,467,692).

Re claim 1: Tarantino et al teaches a data carrier comprising a microcircuit 10; and a card body 1, wherein the card body is formed by a base including a cavity 5 having a bottom and an internal part fixed inside the cavity to which the microcircuit is joined, the internal part and the microcircuit constitute at least a part of a second microcircuit card 2. (See abstract; figures 1-2; col. 2, line 32 to col. 3, line 65)

Re claim 2: Tarantino et al teaches wherein the internal part is at least as flexible as the base (see col. 2, line 32 to col. 3, line 65).

Re claim 3: Tarantino et al teaches wherein the length and width of the cavity 5 are substantially equal to length and width of the internal part of the second microcircuit card 2. (See figure 2; col. 2, line 32 to col. 3, line 65)

Re claim 4: Tarantino et al teaches wherein the depth of the cavity 5 is substantially equal to the thickness of the second microcircuit card 2 (see figure 2).

Re claim 5: Tarantino et al teaches wherein second microcircuit card 2 is fixed in a detachable manner in the base (see col. 2, line 32 to col. 3, line 65).

Re claim 6: Tarantino et al teaches wherein the second microcircuit card is fixed permanently in the base (see col. 2, line 32 to col. 3, line 65).

Re claim 7: Tarantino et al teaches wherein the second microcircuit card is in conformity with Standard ID-000 (see col. 2, line 32 to col. 3, line 65).

Re claim 8: Tarantino et al teaches wherein the internal part and the microcircuit together constitute the whole of the second microcircuit (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 10: Tarantino et al teaches wherein the bottom of the cavity is closed (see figure 2).

Re claim 11: Tarantino et al teaches wherein the bottom of the cavity comprises at least one opening (see figure 2).

Re claim 12: Tarantino et al teaches wherein the microcircuit is mounted on a module, which together with the internal part constitutes at least part of the second microcircuit card (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 13: Tarantino et al teaches wherein the microcircuit cooperates with an antenna 3 provided on the internal part such that the second microcircuit is contactless (see figures 1 and 2; col. 2, line 32 to col. 3, line 65).

Re claim 14: Tarantino et al teaches wherein the internal part and the microcircuit constitute a part of the second microcircuit card which includes a part of the body of the second microcircuit card (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 15: Tarantino et al teaches wherein the cavity is a slot formed in the thickness of the base (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 16: Tarantino et al teaches wherein the cavity is provided with a roof opposite the bottom, the roof and the bottom being formed by edges bordering the second microcircuit card over at least a part of the second microcircuit card periphery (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 17: Tarantino et al teaches wherein the base is provided with a connection to enable the base to be joined to another object (see figures 1 and 2; col. 2, line 32 to col. 3, line 65).

Re claim 19: Tarantino et al teaches wherein the cavity opens from the base by a face (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 20: Tarantino et al teaches wherein the cavity opens from the base by an edge (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claims 21 and 23: Tarantino et al teaches an adapter base having an external geometry of a microcircuit card of a first format; and a cavity with a bottom for accommodating a second microcircuit card in a second format, wherein the cavity comprises lateral recesses (see figure 2; col. 2, line 32 to col. 3, line 65).

Re claim 24: Tarantino et al teaches wherein the cavity opens from the base by a face (see figure 2).

Re claim 25: Tarantino et al teaches wherein the cavity opens from the base by an edge (see figure 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarantino et al (US 6,467,692).

Re claim 9: Tarantino et al discloses the claimed invention except for wherein the base is in the form of a key. It would have been obvious to artisan of ordinary skill in the art to provide a base in the form of a key, since applicants have not disclosed that providing a base in the form of a key solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either feature.

Re claims 18 and 23: Tarantino et al discloses the claimed invention except for wherein the base is provided with a through-hole with dimensions of which permit attachment of a key ring. It would have been obvious to artisan of ordinary skill in the art to provide a base with a through-hole, since applicants have not disclosed that providing a base with a through-hole solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either feature.



***Remarks***

6. The lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e. even though the claims 26-42 are rewritten or amended to overcome the rejection of the 35 U.S.C. 112 as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 6,776,347 to Nishikawa et al

US Pat. No. 6,786,419 to Kayanakis

US Pat. No. 6,685,097 to Housse

US Pat. No. 5,671,525 to Fidalgo

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AAT

12 December 2005

**DANIEL STCYR**  
**PRIMARY EXAMINER**

